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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,902	11/26/2001	Kiichiro Sakamoto	Q66497	7533
7590 01/10/2007 SUGHRUE MION, PLLC 2100 Pennsylvania Avenue, NW Washington, DC 20037-3213			EXAMINER DUNHAM, JASON B	
			ART UNIT	PAPER NUMBER
			3625	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/10/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/991,902

Applicant(s)

SAKAMOTO ET AL.

Examiner

Jason B. Dunham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/18/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 1-47 are pending in this application. Claims 1 and 17 were amended and claims 32-47 were added in applicant's response filed September 21, 2006 to the office action dated March 21, 2006.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 34-35, 40-41, and 46-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner can find no disclosure within the specification regarding a scene comprising a single frame, or a display means located on an exterior wall of a building or in a stadium.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-33,36,38-39,42, and 44-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis (U.S. Patent Application Publication No. 2003/0001846).**

Referring to claim 1. Davis discloses a method of offering a commemorative image on viewing of moving images, comprising the steps of:

- Allowing a customer who is viewing moving images that are displayed on an image display to designate an image of a desired scene out of the moving images and also allowing the customer to place an order for said image of the thus designated scene as accompanied by orderer information which specifies said customer (Davis: abstract, paragraph 190);
- Picking up first digital image data from video signals for said moving images in response to the designation of said desired scene, said first digital image data corresponding to the image of said designated scene (Davis: abstract);
- Creating the commemorative image, using the picked up first digital image data, that is commemorative of the viewing of the moving images and reproduces the image of said designated scene (abstract); and
- Delivering the created commemorative image to said customer after checking it against said orderer information (Davis: abstract, paragraph 190).

Referring to claim 2. Davis further discloses a method comprising the steps of:

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- Storing in a specified memory said first digital image data as picked up from the video signals for said moving images (Davis: paragraph 22);
- Reading said stored first digital image data out of said specified memory (Davis: paragraph 24); and
- Said commemorative image being created using said first digital image data as read out of said specified memory (Davis: paragraph 24).

Referring to claim 3. Davis further discloses a method wherein said commemorative image is created as second digital image data from said first digital image data, and output as a print or prints of the moving images that reproduces said commemorative image from said second digital image data or output as a recording medium or media having said second digital image recorded thereto or created as distribution data from said second digital image data which is to be distributed via a communication network (Davis: paragraphs 22 & 46).

Referring to claim 4. Claim 4 is rejected under the same rationale set forth above.

Referring to claim 5. Davis further discloses a method wherein said commemorative image is delivered to said customer in accordance with an image delivery method designated by said customer (Davis: paragraph 215).

Referring to claim 6. Davis further discloses a method wherein image delivery information that designates said image delivery method is sent with said orderer information when the order for the image of said designated scene is placed by said customer (Davis: paragraph 88-89).

Referring to claim 7. Davis further discloses a method wherein said commemorative image is created as a collection of images of a plurality of designated scenes (Davis: paragraph 215-216).

Referring to claim 8. Davis further discloses a method wherein said collection is an album prepared in a specified format using a plurality of prints of moving images that reproduce said plurality of designated scenes (Davis: paragraphs 207 & 214).

Referring to claim 9. Claim 9 is rejected under the same rationale set forth above.

Referring to claim 10. Davis further discloses a method wherein said first digital image data is composited with an image already prepared by said customer to create said commemorative image (Davis: paragraphs 56 & 206).

Referring to claim 11. Davis further discloses a method wherein said first digital image data for images of designated scenes by said customer are stored in said memory, said first digital image data are read out of said memory and displayed on a monitor, and the image of said designated scene by said customer, for which the order is finally to be placed by the customer is chosen from the thus displayed images of designated scenes by said customer on the monitor (Davis: paragraphs 92-93).

Referring to claim 12. Davis further discloses a method wherein said first digital image data for the images of scenes within a specified time range including not only the image of said designated scene out of said moving images which has been designated by said customer but also images both before and after said image are stored in said memory, said first digital image data are displayed on a monitor, and the image of said

designated scene by said customer, for which the order is finally to be placed by the customer is designated from the thus displayed images of the scenes within said specified time range on the monitor (Davis: paragraph 72).

Referring to claim 13. Claim 13 is rejected under the same rationale set forth above. The examiner notes that applicant discloses in paragraph 114 the fifth embodiment being essentially as the first embodiment with the exception of "picking the closest scene" to the designated scene. It is unclear what is intended by the term "closest", however it was taken to mean the nearest to the designated scene timewise. Dave discloses a method wherein images immediately surrounding the designated scene in sequential order are selected (Davis: paragraphs 197-198).

Referring to claim 14. Davis further discloses a method wherein statistics are taken of frequency of said designation of the desired scene and prior to designation of the desired scene by said customer, a commemorative image is made available for each of the images of frequently designated scenes (Davis: paragraphs 265-267).

Referring to claim 15. Davis further discloses a method wherein a biological reaction occurring in said customer is utilized to designate the image of said desired scene (Davis: paragraphs 143-144 and 196)

Referring to claim 16. Davis further discloses a method wherein said biological reaction is the movement and attitude of eyeballs of said customer (Davis: paragraphs 143-144 and 150).

Referring to claims 17-31. Claims 17-31 are rejected under the same rationale set forth above.

Referring to claims 32-33,36,38-39,42, and 44-45. Davis further discloses methods and systems wherein the moving images are a movie played in a movie theatre, the image display means is a screen (Davis: paragraphs 58-61), wherein the image display means is a video projector (Davis: paragraph 14), and wherein the image display means is a display unit located in a building (Davis: paragraph 188)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (U.S. Patent Application Publication No. 2003/0001846) in view of McIntyre (U.S. Patent Application Publication No. 2004/0172646).**

Referring to claims 37 and 43. Davis discloses all of the above as noted in the 102(e) rejection but does not expressly disclose a method or system wherein said image display means is a television. McIntyre discloses a method and system of offering a commemorative image on viewing of moving images wherein said image display means is a television (McIntyre: paragraph 164). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method and system of Davis to have included an image display means that is a



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television, as taught by McIntyre, in order to obtain photographic products while using a cable set top box (McIntyre: abstract).

### ***Response to Arguments***

Applicant's arguments regarding claims 1-31 have been fully considered but they are not persuasive. Applicant argues that Davis does not disclose a user designating an image of a desired scene from moving images. The examiner disagrees and notes paragraph 183 of Davis disclosing, "The database is designed to allow users to select among different captured video, stills....". Clearly, Davis anticipates a user choosing a desired scene from moving images. Claims 2-11 and 13 are rejected under the same rationale.

Regarding claim 12, applicant further argues that Davis does not disclose display of such unstructured part so as for the user to finally place an order by referring to the display. The examiner notes that Davis clearly anticipates storing images both before and after the designated scene by said customer within a specified time range in paragraphs 193-197. Davis disclose timing the length of moving images based upon user input and then allowing a user to select a desired scene from among those images as disclosed above in the response regarding claim 1.

Regarding claim 14, the examiner notes the claim language reading, "The method according to claim 1, wherein **statistics is taken** of frequency of said designation of the desired scene and **prior** to designation of the desired scene by said customer, a commemorative image is made available for each of the images of

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frequently designated scenes". Grammatically, the claim should read, "statistics are taken". Furthermore, as claim 14 depends upon claim 1, it is noted that statistics could not be taken regarding the designation of a desired scene PRIOR to designation of a scene by a customer, as said customer is the only user capable of designating a desired scene.

Regarding claim 15, wherein a biological reaction (such as movement and attitude of eyeballs of said customer) occurring in said customer is utilized to designate the image, the examiner notes paragraphs 143 and 144 of Davis. The designated frame is not taken until the user stops moving and the user's eyes are facing (attitude) the camera. Claim 16 is rejected under the same rationale.

Claims 17-31 are rejected under the same rationale set forth above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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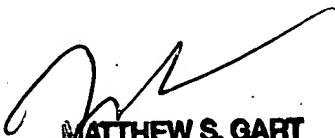
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBD  
Patent Examiner  
1/3/07

  
**MATTHEW S. GART**  
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